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EXAMINER

GREENE, DANIEL L

ART UNIT PAPER NUMBER

3621

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,041

Applicant(s)

HILLEGASS ET AL.

Examiner

Daniel L. Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,5-12 and 14-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3,5-12 and 14-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 2,3,5-12, and 14-23 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 5, 6, 12, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spagna et al. U.S. Patent 6,587,837 [Spagna], and further in view of Peinado et al. U.S. Patent 6,775,655 B1 [Peinado] and Colosso, U.S. Patent 6,169,976 [Colosso]

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As per claims 2, 12, and 15:

Spagna discloses:

receiving a request, via a computer network, for product registration from a vendor, said request including a product name and a vendor identifier; Col. 46, lines 25-40.

assigning a product identifier and an encryption key to said product and forwarding registration to vendor, said registration including a product identifier, said key and said vendor identifier; Col. 51, lines 15-67.

receiving a request, via a computer network, from a user for a user license, said request including user name and payment information; Col. 79, lines 25-67.

assigning a user identifier to said user and forwarding a user license, via a computer network, to said user, said license including said user identifier; Fig. 6.

Spagna discloses the claimed invention except for receiving a request, via a computer network, for a product license from said user to use said product, said request including said user identifier and said product identifier. However, Spagna does teach about Content ID (Col. 31, lines 40-45) and Content Provider verification. Col. 14, lines 1-50. Peinado teaches that it is known in the art to provide receiving a request, via a computer network, for a product license from said user to use said product, said request including said user identifier and said product identifier. Col. 7, lines 1-35.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the method of delivering electronic content from an online store of Spagna with the receiving a request, via a computer network, for a

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product license from said user to use said product, said request including said user identifier and said product identifier of Peinado, in order to be able to associate a specific user with a specific product.

Spagna discloses the claimed invention except for issuing a product license to said user, said product license including a user identifier, the product identifier and a decryption key that mates with said encryption key. However, Spagna does teach watermarking and encrypting the digital data. Fig. 8. Peinado teaches that it is known in the art to provide issuing a product license to said user, said product license including a user identifier, the product identifier and a decryption key that mates with said encryption key. Col. 11, lines 9-25. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the method of encrypting data by Spagna with the issuing a product license to said user, said product license including a user identifier, the product identifier and a decryption key that mates with said encryption key of Peinado, in order to further enhance the security and use of the data,

Spagna discloses the claimed invention except for storing in a relational database the vendor records, product records, user records and product license records, with the product record linked to the vendor record via the vendor identifier, and with the each product license linked to a user record via the user identifier. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to storing in a relational database the vendor records, product records, user records and product license records, with the product record linked to the vendor record via the vendor

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identifier, and with the each product license linked to a user record via the user identifier since it is known in the art that storing in a relational database the vendor records, product records, user records and product license records, with the product record linked to the vendor record via the vendor identifier, and with the each product license linked to a user record via the user identifier as taught by Peinado Col. 18, line 18 [license store] and Colosso, Col. 3, lines 1-65.

As per claim 3:

Spagna discloses:

downloading encrypted digital material carrying a product identifier; Col. 26, lines 50-67, Col. 27, lines 1-30.

purchasing a product license to use the material, said product license including a decryption key to decrypt the material and the product identifier. Col. 29, lines 5-67, Col. 30, lines 1-33.

Spagna discloses the claimed invention except for the request including a specific product identifier. However, Spagna does teach about Content ID (Col. 31, lines 40-45) It would have been obvious to one having ordinary skill in the art at the time the invention was made to interchange the names Content ID with product identifier and effectively not change the system and methods taught.

Spagna does not expressly show obtaining a unique global user license, said user license including a user identifier. However these differences are only found in the

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nonfunctional descriptive material and are not functionally involved in the steps recited.

The obtaining a user license step, said user license including a user identifier would be performed the same regardless if it was a "unique global license" or a user license.

Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to obtain a user license, said user license including a user identifier or a unique global user license, said user license including a user identifier, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Spagna discloses the claimed invention except for wherein said product license includes said user identifier and wherein when a user purchases multiple product licenses each product license is linked to the global user license via the unique user identifier.

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to wherein said product license includes said user identifier and wherein when a user purchases multiple product licenses each product license is linked to the global user license via the unique user identifier since it is known in the art that wherein said product license includes said user identifier and wherein when a user purchases multiple product licenses each product license is linked to the global user

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license via the unique user identifier as taught by Peinado Col. 18, line 18 [license store] and Colosso, Col. 3, lines 1-65.

As per claim 5:

Spagna discloses the claimed invention except for the establishing a connection for data transmission between the user's computer and a license provider's computer; transmitting via said data connection to the license provider a request for a user license including a user name and a system identifier that is unique to the user's computer; receiving via data connection a user license from the license provider, said user license including a user identifier assigned by the license provider. However, Spagna does disclose the use of technical platforms for the distribution through point-to-point and broadcast infrastructures. Col. 9, lines 65-67. It would have been obvious to one having ordinary skill in the art at the time the invention was made to realize the benefits of a system, the various parties must make connections, request information and receive data. As previously shown, each transaction entity has its own specific ID.

Spagna does not expressly show the user license as a unique global license. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The receiving via a data connection, a user license step would be performed the same regardless if it was a unique global user license or a user license. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re*

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Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to receive via a data connection a user license or a unique global user license because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 6:

Spagna further discloses:

storing the user license on said user's computer. Col. 14, lines 48-67.

As per claim 14:

Spagna further discloses: Col. 73-74, lines 1-67.

wherein said database stores product registration records, each said record including a vendor identifier and an encryption key.

Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spagna, Peinado and Colosso as applied to claims 2, 3, 5, 6, 12, 14 and 15 above, and further in view of Knapton, III, U.S. Patent 6,363,486 B1 [Knapton].

As per claims 7 and 10:

Spagna, Peinado, and Colosso disclose the claimed invention except for the steps of selecting and transmitting a password to the license provider and said user license incorporating said password. Knapton teaches that it is known in the art to provide the steps of selecting and transmitting a password to the license provider and said user license incorporating said password. Col. 6, lines 1-15. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the security procedures of Spagna, Peinado, and Colosso with the steps of selecting and transmitting a password to the license provider and said user license incorporating said password of Knapton, in order to ensure that unlicensed copies of software components cannot operate with associated application programs.

As per claim 8:

Spagna, Peinado, and Colosso disclose the claimed invention except for the said request including a system identifier. Knapton teaches that it is known in the art to provide said request including a system identifier. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the security procedures of Spagna with the steps of said request including a system identifier of

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Knapton, in order to ensure that unlicensed copies of software components cannot operate with associated application programs.

As per claim 9:

Spagna further discloses:

wherein each said user license record includes a user name. Col. 21, lines 55-67, Col. 22, lines 1-30.

As per claim 11:

Spagna further discloses:

user license record includes the user's credit card number. Col. 50, lines 13-35.

2. Claims 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peinado.

As per claim 16:

Peinado disclose:

means for downloading a digital media product containing a product identifier.
Col. 6, lines 1-35.

means for storing downloaded digital material. Col. 5, lines 16-45.

registry in device for playing the material, the registry containing a system identifier. Col. 13, lines 60-67.

- d) user license stored in the registry of the media player device, said user license containing a user identifier. Fig. 4, License Store 38
- e) product license stored in memory that is operationally accessible to software running on the player, said product license containing the product identifier and the user identifier of the person authorized to play the material. Col. 15, lines 63-56, Col. 16, lines 10-35.
- f) software for comparing the user identifier in the product license to the user identifier on the user license each time the software receives a request to play the product. Col. 14, lines 40-50.

Peinado discloses the claimed invention except for specifically identifying software for comparing. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to have software for comparing since it is known in the art that as shown in Fig. 4, for the User's Computing Device to function, it must have the software to do the rendering and running of the Digital Rights Management System 32.

As per claim 17:

Peinado disclose:

a user license containing a user identifier, said license stored on a computer. Col. 5, lines 16-45.

a product license containing a product identifier and the user identifier of a person authorized to access the product file. Col. 15, lines 63-56, Col. 16, lines 10-35.

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product file stored on the computer. Col./ 13, lines 30-45.

license type stored in said product license, said license type determining constraints for playing and viewing product. Col. 14, lines 42-60.

Peinado discloses the claimed invention except for no license type or use constraints stored in said product file. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to have no license type or use constraints stored in said product file since it is known in the art that the data controlling the use of a product is attached to the data and not contained in the product file itself.

As per claim 18:

Peinado disclose:

issuing a digital product license via a computer network to a user containing a unique product identifier. Col. 11, lines 9-25.

Peinado discloses the claimed invention except for distributing without regard to whether the user has a license to play the product file. Peinado does teach about distributing the digital content freely and widely. Col. 4, lines 55-57. Also, Peinado discloses preview information designed to provide the user with a preview of the digital content. Col. 7, lines 59-60. . It would have been obvious to one having ordinary skill in the art at the time of the invention was made to distribute without regard to whether the user has a license to play the product file since it is known in the art that distributing digital material product files without regard to whether the user has a license to play the

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product file provides the opportunity that the user may desire to have access to the product file after reviewing the trailers.

As per claim 19:

Peinado discloses the claimed invention except for issuing a user license containing a user identifier, said user identifier containing no reference to a digital material product file, nor any reference to a purchase transaction for any particular product file. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to issuing a user license containing a user identifier, said user identifier containing no reference to a digital material product file, nor any reference to a purchase transaction for any particular product file since it is known in the art that issuing a user license containing a user identifier, said user identifier containing no reference to a digital material product file, nor any reference to a purchase transaction for any particular product file can provide the user with certification and authentication as to who they are.

As per claim 20:

Peinado disclose the claimed invention except for in a central database for assigning product identifiers to products generated by multiple vendors, assigning said unique product identifier and an encryption key to a digital material product file. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to in a central database for assigning product identifiers to products generated by

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multiple vendors, assigning said unique product identifier and an encryption key to a digital material product file since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Peinado further disclose:

encrypting at least a portion of the content in the digital material product file according to said key. Col. 7, lines 1-15

distributing a digital material product file containing a product identifier, without regard to whether the user has a license to play the product file. Col. 7, lines 50-65.

issuing a digital product license via a computer network to a user, said product license containing a unique product identifier and the associated decryption key. Col. 7, lines 1-35.

As per claim 21:

Peinado further disclose:

in a digital material product file, encrypting a portion of the content while leaving a portion of the content unencrypted to allow a user to preview the unencrypted portion before obtaining a product license to decrypt the product file. Col. 7, lines 50-65.

As per claim 22:

Peinado discloses the claimed invention except for issuing a user license containing a user identifier, said user identifier containing no reference to a digital

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material product file, nor any reference to a purchase transaction for any particular product file. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to issuing a user license containing a user identifier, said user identifier containing no reference to a digital material product file, nor any reference to a purchase transaction for any particular product file since it is known in the art that issuing a user license containing a user identifier, said user identifier containing no reference to a digital material product file, nor any reference to a purchase transaction for any particular product file can provide the user with certification and authentication as to who they are.

Peinado further disclose:

issuing a digital product license to a user via computer network, said product license containing a product identifier and a user identifier. Col. 10, lines 30-67.

As per claim 23:

Peinado discloses the claimed invention except for issuing a user license containing a user identifier, said user identifier containing no reference to a digital material product file, nor any reference to a purchase transaction for any particular product file. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to issuing a user license containing a user identifier, said user identifier containing no reference to a digital material product file, nor any reference to a purchase transaction for any particular product file since it is known in the art that issuing a user license containing a user identifier, said user identifier containing

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no reference to a digital material product file, nor any reference to a purchase transaction for any particular product file can provide the user with certification and authentication as to who they are.

Peinado does not expressly show issuing multiple digital product licenses to a user via computer network, each said product license containing a unique product identifier, and each said product license containing the same said user identifier.

However, Peinado does teach about issuing a digital user license. Col. 10, lines 35-67.

The differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited issuing step would be performed the same regardless if it was a single or for multiple. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to issue either single or multiple licenses because such actions does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures

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may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703-306-5539. The examiner can normally be reached on M-Thur. 8am-6pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12/07/2004

DLG



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